

REMARKS

I. Status of Claims

Claims 1-9 are pending in the application. Claims 1, 5, and 6 are independent. Claims 1-3 and 5-8 are currently amended.

Claim 5 is objected to because of the following alleged informalities: “amount” is misspelled in line 15; lines 6-7 are phrased in a confusing manner “a rotational speed of the motor of a predetermined rotational speed.”

Claim 6 is objected to because of the following alleged informalities: “out put” is misspelled in line 11. Appropriate correction is required.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 5 and 6¹ are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Tabata et al. (USP5,833,570) (“Tabata”).

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tabata in view of Eguchi et al. (USPUB 2003/0109360 A1) (“Eguchi”).

Claims 3 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicant respectfully requests reconsideration of the rejections in view of the foregoing amendments and the following remarks.

¹ Although the Office Action, on page 3 (in bold), only indicates that claims 1 and 2 are rejected, the Applicant notes that it appears that claims 1, 2, 5, and 6 stand rejected.

II. Allowable Subject Matter

Claims 3 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

III. Claim Objections and 35 USC 112, second paragraph, Rejections

Claims 5 and 6 are objected to because of minor informalities. Also, claims 1-9 stand rejected under 35 USC 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant respectfully submits that “amount” is not misspelled in claim 5 as alleged. With respect to claim 3, The Applicant respectfully submits that antecedent basis for initial output torque can be found in claim 2. Concerning claims 4 and 9, claims 1 and 6 also appear to provide antecedent basis for the output torque of claims 4 and 9, respectively.

It is respectfully submitted that the foregoing amendments should obviate any perceived ambiguity with respect to the remaining objections/rejections.

IV. Pending Claims

Claims 1, 5, and 6, the only independent claims, stand rejected under 35 USC 102(b) as allegedly being anticipated by Tabata.

The Applicant respectfully submits claim 1 is patentable over Tabata at least because it recites, *inter alia*, “...learning means for learning a relationship between an output torque of the motor for maintaining the rotational speed of the motor at the predetermined rotational speed and the engagement control amount when the output torque of the motor reaches ***a predetermined value while the engagement control amount is changed.***” (emphasis added)

The Applicant respectfully submits claim 5 is patentable over Tabata at least because it recites, *inter alia*, “...learning a relationship between an output torque of the motor and the

engagement control amount when the output torque of the motor for maintaining the rotational speed of the motor at the predetermined rotational speed reaches ***a predetermined value while the engagement control amount is changed.***” (emphasis added)

The Applicant respectfully submits claim 6 is patentable over Tabata at least because it recites, *inter alia*, “...a third control device which learns a relationship between an output torque of the motor for maintaining the rotational speed of the motor at the predetermined rotational speed and the engagement control amount when the output torque of the motor reaches ***a predetermined value while the engagement control amount is changed.***” (emphasis added)

In order to reject the Applicant’s learning means, learning step (of method claim 5), and third control device limitations, the Office Action, on page 4, cites the learning compensation data map memory means 160 of Tabata. That said, the data maps stored in the memory means 160 consist of a first group of data maps used in step SB4 followed by steps SB5-SB7 implemented by the motor control means 156, and a second group of data maps used in step SB11 followed by steps SB12-SB14 implemented by the engine control means 157. The data maps of each group correspond to respective combinations of the shifting action of the automatic transmission 14 and the vehicle running conditions such as the operation mode of the hybrid drive system 10 and the input shaft torque T_1 . See col. 29, lines 49-65 of Tabata.

However, in contrast to the inventions of claims 1, 5, and 6, Tabata does not teach or suggest learning a relationship between an output torque of the motor for maintaining the rotational speed of the motor at the predetermined rotational speed and the engagement control amount when the output torque of the motor reaches ***a predetermined value while the engagement control amount is changed.*** The Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Also, with respect to claims 1 and 6 (the steps of claim 5 should be afforded additional patentable weight since they are describing a method), the Applicant respectfully submits the functional limitations of these

claims must be evaluated and considered, just like any other limitation of the claim, for what they fairly convey to a person of ordinary skill in the pertinent art in the context in which they are used. For example, a functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. *See* MPEP 2173.05(g).

Accordingly, The Applicant respectfully submits, lacking any teaching and/or suggestion of such a learning means, learning step, and/or third control device, Tabata does not anticipate the inventions of claims 1, 5, and 6.

Also, The Applicant respectfully submits the other cited references do not identify a reason why one of ordinary skill in the art would modify Tabata in the manner as claimed by the Applicant. The Applicant respectfully submits that, as discussed in *KSR Int'l Co. v. Teleflex, et al.*, No. 04-1350, (U.S. Apr. 30, 2007), it remains necessary to identify the reason why a person of ordinary skill in the art would have been prompted to combine alleged prior art elements in the manner as claimed by the Applicant. Obviousness cannot be sustained upon mere conclusory statements.

Therefore, the Applicant respectfully submits that, for at least these reasons, claims 1, 5, and 6 are patentable over the cited references.

The dependent claims further distinguish certain embodiments of the present invention from Tabata. For example, claim 2 (also claim 7 generally tracks claim 2) recites that, "...detecting means for detecting an initial output torque of the motor while the engagement control amount is zero, and ***the predetermined value is set to a value obtained by adding a predetermined torque to the initial output torque detected by the detecting means.***" (emphasis added). It is noted that the Office Action generally alleges on page 4, that in FIG. 19, "the predetermined value is set to a value obtained by adding predetermined torque to the initial output torque detected by the detecting means;" however, The Applicant respectfully submits Tabata does not describe adding a predetermined torque to the initial output torque as claimed.

V. Conclusion

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Office Action is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Date: May 1, 2009

By: /Daniel G. Shanley/
Daniel G. Shanley
(Reg. No. 54,863)

KENYON & KENYON LLP
1500 K Street, N.W. - Suite 700
Washington, D.C. 20005
Tel: (202) 429-1776
Fax: (202) 429-0796